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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Confirmation No. 5520  
Hiroki MAEDA et al. : Attorney Docket No. 2006\_0043A  
Serial No. 10/565,104 : Group Art Unit 1753  
Filed January 19, 2006 : Examiner Anca Eoff

PHOTOSENSITIVE RESIN COMPOSITION : Mail Stop: AMENDMENT  
AND METHOD OF FORMING A PATTERN  
USING THE COMPOSITION

**REQUEST TO REMOVE SUSPENSION OF ACTION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

THE COMMISSIONER IS AUTHORIZED  
TO CHARGE ANY DEFICIENCY IN THE  
FEES FOR THIS PAPER TO DEPOSIT  
ACCOUNT NO 23-0975

Sir:

In the Petition for Suspension of Action dated January 8, 2008, suspension of action was requested in order to provide adequate time to prepare a Declaration Under 37 CFR 1.131.

Such Declaration is submitted herewith and, accordingly, it is hereby requested that this application be returned to active prosecution and that the attached Declaration Under 37 CFR 1.131 be considered.

It is also respectfully requested that consideration now be given to the Response filed on December 12, 2007.

Respectfully submitted,

Hiroki MAEDA et al.

By: Matthew M. Jacob  
Matthew M. Jacob  
Registration No. 25,154  
Attorney for Applicants

MJ/aas  
Washington, D.C. 20006-1021  
Telephone (202) 721-8200  
Facsimile (202) 721-8250  
February 7, 2008



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**PHOTOSENSITIVE RESIN COMPOSITION AND METHOD OF FORMING A PATTERN USING THE COMPOSITION** : **MAIL STOP: AMENDMENT**

DECLARATION UNDER 37 CFR 1.131

Hiroki MAEDA, Toru TAKAHASHI and Naoya KATSUMATA declare:

1. That they are the inventors of the subject application.
2. That certain claims of the present application have been rejected as anticipated by Weber et al. (U.S. 2005/0260522), with an effective date which may be as early as February 13, 2004.
3. That they completed the present invention well prior to that date as evidenced by the following:

- Application 3 (the present application) was filed with the Japanese Patent Office, as a PCT application, on December 15, 2004, claiming the benefit of the priority date of Application 2, filed on March 26, 2004.

- Application 2 was filed with the Japanese Patent Office, claiming the benefit of the domestic priority date of Application 1 (Japanese Unexamined Patent Application Publication No. 2003-279489), filed July 24, 2003.

The application history is depicted as follows:

February 13, 2004		
July 24, 2003	March 26, 2004	December 15, 2004
(Application 1) JP 2003-279489	(Application 2) JP 2004-93624	(Application 3) PCT Application (Present Application) PCT/JP2004/018759
Weber et al. Provisional 60/544,403		

#### Provisional Application

The invention recited in claims 9 and 12 of the present application is supported by the disclosure of Application 1, as stated below (please find attached a certified copy of Application 1 and an English translation thereof).

Claims 9 and 12 are directed to a photosensitive resin composition, comprising a multi-functional bisphenol A novolac epoxy resin, the functionality of which is 5-functional groups or more, as depicted by general formula (3), a cationic polymerization initiator represented by general formula (1), and a naphthol sensitizer.

Application 1 discloses a photosensitive resin composition comprising a multi-functional epoxy resin, a cation polymerization initiator which can be represented by general formula (1) of the present application, and a naphthol sensitizer.

When the invention of Application 1 is compared to the invention of the present application, it is apparent that both inventions have a common feature, namely the inclusion of a cationic polymerization initiator and a naphthol sensitizer.

Additionally, Application 1 discloses a multi-functional bisphenol A novolac epoxy resin, a functionality of which is 5-functional groups or more, as discussed below, and which can be represented by general formula (3) of the present application.

In the present application, EPICOAT 157S70 is disclosed as an example of a multi-functional bisphenol A novolac epoxy resin, the functionality of which is 8-functional

groups, represented by general formula (3) (paragraphs [0023] and [0025] in the present application).

Application 1 discloses EPICOAT 157S70 as an example of a multi-functional bisphenol A epoxy resin, the functionality of which is 8-functional groups, which can be represented by general formula (3) of the present application (paragraphs [0019] and [0021] in Application 1).

The present application discloses a multi-functional bisphenol A novolac epoxy resin, a functionality of which is 8-functional groups, and similarly in Application 1, a multi-functional bisphenol A epoxy resin, the functionality of which is 8-functional groups, is disclosed i.e. the same compound.

As described above in Application 1, a bisphenol A epoxy novolac resin is disclosed as an example of a multi-functional epoxy resin. Furthermore, the functionality is disclosed as, " . . . functionality having 5-functional groups or more is preferable. In particular, a 8-functional bisphenol A epoxy resin (product name: 'EPICOAT 157S70', supplied from Japan Epoxy Resin Co., Ltd.) is preferable". See paragraph [0021] in Application 1. Accordingly, it can be seen that Application 1 discloses a multi-functional bisphenol A novolac epoxy resin, the functionality of which is 5-functional groups or more, which can be represented by general formula (3) of Application 1.

4. That said Japanese Application constitutes an actual reduction to practice of the present invention well prior to the February 13, 2004 date of the Weber publication.
5. That said Japanese priority application constitutes a conception of the invention at a date prior to Weber.
6. That applicants diligently completed their invention from a period of time just prior to the February 13, 2004 date of Weber until the filing of JP 2004-93624 (Application 2) of the present application, filed March 26, 2004.

For the foregoing reasons, the Weber reference is antedated by the present application.

We further declare that all statements made herein of our own knowledge are true, and that all statements on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Jan. 24, 2008

Date

Hiroki Maeda

Hiroki MAEDA

Jan. 7, 2008

Date

Toru Takahashi

Toru TAKAHASHI

Jan. 14, 2008

Date

Naoya Katsumata

Naoya KATSUMATA